

REMARKS

This Reply is in response to the Office Action mailed on August 30, 2004 in which Claims 1-18 were rejected. With this response, Claims 1, 7 and 18 are amended and Claims 19-37 are added. Claims 1-37 are presented for reconsideration and allowance.

I. Examiner Interview Summary.

On October 19, 2004, a telephonic interview was held between Examiner Kim and Applicants' attorney, Todd A. Rathe. The rejections of Claims 1 and 15-18 based upon Gattone, U.S. Patent No. 3,310,830, and Gebauer, U.S. Patent No. 2,171,501, were discussed. It was tentatively agreed upon that Claim 1, as amended above, overcomes the rejection based upon Gattone. No further agreement was reached.

Applicants wish to thank Examiner Kim for the opportunity to discuss the rejections and for Examiner Kim's suggestions for amending Claim 1 to overcome the rejection based upon Gattone.

II. Rejection of Claim 18 Under 35 U.S.C. § 112, Second Paragraph.

Paragraph 2 of the Office Action rejected Claim 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point and distinctly claim the subject matter of the invention. In particular, paragraph 2 noted that the limitation "the dispensing axis" lacks antecedent basis. In response, Claim 18 is amended to replace "dispensing axis" with -- longitudinal axis of the container-- which finds antecedent basis in Claim 1. Accordingly, Claim 18, as amended, overcomes the rejection under 35 U.S.C. § 112, second paragraph.

III. Rejection of Claims 1, 3-6, 8-10, 14, 15 and 17 Under 35 U.S.C. § 102(b) Based Upon Gattone.

Paragraph 4 of the Office Action rejected Claims 1, 3-6, 8-10, 14, 15 and 17 under 35 U.S.C. § 102(b) as being anticipated by Gattone, U.S. Patent No. 3,310,830. As discussed above, during the interview held on October 19, 2004, it was tentatively agreed upon that Claim 1, as amended, overcomes the rejection based upon Gattone. In particular, it was

agreed upon that Gattone fails to disclose a container extending along a longitudinal axis, a nozzle coupled to the container and having an outlet opening and an actuator, wherein the nozzle has a longitudinal axis, wherein the outlet opening lies along the longitudinal axis of the nozzle and wherein the longitudinal axis of the nozzle is substantially parallel or coextensive with the longitudinal axis of the container. In contrast, Gattone merely discloses an applicator having a nozzle and a nozzle opening which extend along an axis perpendicular to the longitudinal axis of the container. Thus, Claim 1, as amended, overcomes the rejection based upon Gattone. Claims 2-18 depend from Claim 1 and overcome the rejection based upon Gattone for the same reason.

IV. Rejection of Claims 1-4, 6, 7, 11, 12, 13, 15 and 17 Under 35 U.S.C. § 102(b) Based Upon Gebauer.

Paragraph 5 of the Office Action rejected Claims 1-4, 6, 7, 11, 12, 13, 15 and 17 under 35 U.S.C. § 102(b) as being anticipated by Gebauer, U.S. Patent No. 2,171,501. With this response, Claims 1 and 7 are amended. Claims 1-4, 6, 7, 11, 12, 13, 15 and 17, as amended, overcome the rejection based upon Gebauer.

A. Claim 1.

Claim 1, as amended, recites a nail polish under pressure within the container. Paragraph 5 of the Office Action asserted that the original recited “nail polish” was merely considered a descriptive phrase defining the intended use of the device and was given no patentable weight. In response, Claim 1, as amended, now positively recites a nail polish within the container.

Gebauer fails to disclose or suggest a nail polish applicator which includes a nail polish under pressure within a container. Paragraph 5 of the Office Action asserted that “The device of Gebauer is not prohibited from being used as a nail polish applicator.” However, with this statement, the Examiner has turned the burden of proof requirements regarding anticipation and obviousness on their head. The Examiner seems to assert that the Applicant has the burden of showing why the device of Gebauer could not be used as a nail polish

applicator. However, the law does not require the applicant to show that a prior art reference cannot be modified to meet a claim limitation.

In contrast, it is the Examiner who must establish a prima facie case of obviousness. Claim 1, as amended, positively recites a nail polish within the container. Paragraph 5 of the Office Action has failed to establish a prima facie case of how or why one of ordinary skill in the art would use the dispensing receptacle of Gebauer as a nail polish applicator or would fill the receptacle of Gebauer with nail polish under pressure. Gebauer fails to provide any motivation or suggestion for its use as a nail polish applicator or that it may alternatively be filled with nail polish.

Moreover, Gebauer would seemingly actually teach away from its use for dispensing nail polish. Gebauer specifically states that “This invention relates to a dispensing receptacle for volatile liquids.” (col. 1, lines 1-2). Volatile liquids are which liquids which readily evaporate. Nail polish is not a volatile liquid. In addition, Gebauer specifically states the volatile liquid is to be capable of being “ejected under the force of its own vapor pressure.” (col. 1, lines 50-51). Nail polish would seemingly produce an insufficient vapor pressure for its ejection in the receptacle of Gebauer. As a result, Claim 1, as amended, overcomes the rejection based upon Gebauer. Claims 2-4, 6, 7, 11, 12, 13, 15 and 17 depend from Claim 1 and overcome the rejection for the same reasons.

B. Claim 7.

Claim 7, as amended, depends from Claim 1 and recites that the actuator includes a trigger pivotally coupled to the housing about a pivot axis on a first side of the longitudinal axis of the nozzle. Claim 7 further recites that the trigger has a depressment surface on a second opposite side of the longitudinal axis of the nozzle. The Applicants note that depressment surface simply means a surface that is engaged by a person’s finger during actuation or movement (sliding or pivoting of the trigger).

Gebauer fails to disclose an actuator which includes a trigger pivotally coupled to the housing about a pivot axis on a first side of the longitudinal axis of the nozzle and a depressment surface on a second opposite side of the longitudinal axis of the nozzle. In

contrast, the surface of lever 18 and the axis about which lever 18 pivots are both located on the same side of the longitudinal axis of nozzle 19. Thus, Claim 7, as amended, overcomes the rejection based upon Gebauer for this additional reason.

C. Claim 12.

Claim 12 recites that the actuator includes a trigger and wherein the actuator further includes a cap configured to removably cover the trigger. Paragraph 5 of the Office Action characterizes deformable sealing element 22 of Gebauer as a “cap”. However, sealing element 22 of Gebauer does not removably cover lever 18 (characterized as the trigger). Accordingly, the rejection of Claim 12 based upon Gebauer is improper and should be withdrawn.

V. Rejection of Claims 16 and 17 Under 35 U.S.C. § 103(a) Based Upon Gattone.

Paragraph 7 of the Office Action rejected Claims 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Gattone, U.S. Patent No. 3,310,830. For the reasons which follow, Applicants respectfully request that the rejection of Claims 16 and 17 be withdrawn.

Claim 16 depends from Claim 1 and recites that the container has a maximum outer diameter of 1 inch proximate the actuator. Claim 18 depends from Claim 1 and recites that the actuator is no greater than 1.5 inches from the outlet in a direction along the longitudinal axis of the container. As set forth on page 7 in paragraph 25, “As a result of the close proximity of trigger 48 to outlet 42, a user of applicator 30 may more closely position his or her fingers (including his or her trigger finger) to outlet 42, enabling greater control and precision when applying the nail polish to the nail.”

Gattone fails to disclose that the container has a maximum outer diameter of 1 inch proximate the actuator or that the actuator is no greater than 1.5 inches from the outlet in a direction along the longitudinal axis of the container. Paragraph 7 of the Office Action acknowledges that Gattone fails to disclose the recited diameter of the container proximate the actuator. Paragraph 7 of the Office Action also acknowledges that Gattone fails to disclose the distance of the actuator from the outlet. As a result, the Office Action attempts to

satisfy this acknowledged deficiency by asserting that it would have been obvious to one of ordinary skill in the art to limit the container outer diameter proximate the actuator to not greater than 1 inch and to limit the actuator from the outlet to not greater than 1.5 inches in a direction along the axis “since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” However, nowhere does Gattone even disclose the “general conditions” of either Claims 16 or 18. In fact, Gattone fails to disclose any dimensions for its applicator.

Moreover, Gattone fails to provide any motivation or suggestion for its modification which would result in the container having a maximum outer diameter of 1 inch proximate the actuator or which would result in the actuator being no greater than 1.5 inches from the outlet. Applicants own disclosure describes these claim features as enabling a user to more closely position his or her fingers to the outlet so as to enable greater control and precision when applying nail polish to the nail.

In contrast, Gattone describes its applicator as a means to deliver material to a relatively large application surface such as a brush, sponge or the like on the face of an applicator plate 20. (col. 3, lines 8-10). Given the use actually taught by Gattone, one of ordinary skill in the art would not be lead to modify Gattone such that the container has a maximum outer diameter of 1 inch proximate the actuator or such that the actuator is no greater than 1.5 inches from the outlet since such precise fine control of the positioning of the nozzle outlet of Gattone is clearly not important as fluid dispensed through the nozzle outlet is to be spread and dispersed by a brush, sponge and the like before even being applied. In fact, one of ordinary skill in the art would probably be lead to alternatively increase the size of the container to enable longer time before the container needs to be replaced and to increase the distance between the actuator and the outlet to enable the applicator to be more easily grasped. Thus, the assertion that it would be obvious to modify Gattone such that the container has a maximum outer diameter of 1 inch proximate the actuator or such that the actuator is no greater than 1.5 inches from the outlet in a direction along the longitudinal axis of the container appears to be based solely upon impermissible hindsight reasoning and is

improper. Therefore, Applicants respectfully request that the rejection of Claims 16 and 18 be withdrawn.

VI. Added Claims.

With this Reply, Claims 19-37 are added. Claims 19-37 depend from Claim 1 and recite additional features which are patentably distinct over the prior art of record. Claims 19-37 are presented for consideration and allowance.

A. Claims 19 and 20.

Claim 19 depends from Claim 1 and further recites a propellant within the container. Claim 20 depends from Claim 19 and recites the propellant is a distinct material from the nail polish.

Neither Gattone nor Gebauer disclose or suggest a container having a nail polish and a propellant within the container. For example, Gebauer specifically states that its dispensing receptacle is for volatile liquids. Gebauer further teaches away from the use of propellant in that the liquid in Gebauer is to be ejected under the force of its own vapor pressure. (col. 1, lines 50-51). Thus, Claims 19 and 20 are believed to be patentably distinct over the prior art of record.

B. Claims 20-23.

Claim 20 depends from Claim 1 and recites a dip tube extending from the nozzle into an interior of the container. Claim 21 recites that the container has an interior side surface and that the tube extends to the interior side surface. Claim 23 recites that the tube has a plurality of openings.

Neither Gebauer nor Gattone disclose a nail polish applicator having the nozzle recited in Claim 1 and further having a dip tube extending from the nozzle into the interior of the container. Neither Gebauer nor Gattone disclose a dip tube which extends to an internal side surface of the container or such a tube that has a plurality of openings. Accordingly, Claims 21-23 are believed to be patentably distinct over the prior art of record.

C. Claims 24-26 and 28-30.

Claim 24 depends from Claim 21 and recites that an aerosol valve assembly between the nozzle and the dip tube. Claim 25 depends from Claim 24 and recites that the valve assembly includes a stem and the valve assembly is actuated to an open state in response to movement of the stem. Claim 26 recites that such movement of the stem to open the valve assembly is along the longitudinal axis of the container.

Claim 28 depends from Claim 1 and recites an aerosol valve assembly between the nozzle and an interior of the container. Claim 29 recites that the valve assembly includes a stem and that the valve assembly is actuated to an open state in response to movement of the stem. Claim 30 recites that movement of the valve assembly to open the actuator is along the longitudinal axis of the container.

The prior art of record fails to disclose the nail polish applicator of Claim 1 with its recited nozzle configuration in conjunction with an aerosol valve assembly. As noted above, Gattone fails to disclose the recited nozzle orientation. Gebauer fails to disclose an aerosol valve assembly. Moreover, Gebauer fails to disclose a valve assembly which includes a stem which is actuated to an open state in response to movement of the stem or that the stem is movable along the longitudinal axis of the container. Thus, added Claims 23-30 are believed to be patentably distinct over the prior art of record.

D. Claim 27.

Claim 27 depends from Claim 21 and further recites a funnel surface tapering towards an inlet of the tube. Neither Gebauer nor Gattone disclose a funnel surface which tapers towards an inlet of a dip tube. Thus, added Claim 27 is believed to be patentably distinct over the prior art of record.

E. Claim 31.

Added Claim 31 depends from Claim 1 and recites that the applicator includes a housing having a frusto-conical portion about the nozzle. The prior art of record fails to disclose an applicator having a frusto-conical portion about the nozzle. For example, cap

element 12 of Gebauer (characterized as the housing in the Office Action) does not have a frusto-conical shape and does not extend about the nozzle. Accordingly, added Claim 31 is believed to be patentably distinct over the prior art of record.

F. Claim 32.

Claim 33 depends from Claim 31 and recites that the actuator includes a trigger having a depressment surface along the frusto-conical portion. The prior art of record fails to disclose an actuator having a trigger with a depressment surface along the frusto-conical portion. For example, even assuming, arguendo, that nozzle 19 of Gebauer were also characterized as a frusto-conical portion of a housing, lever 18 of Gebauer does not extend along nozzle 19. Accordingly, added Claim 32 is believed to be patentably distinct over the prior art of record.

G. Claim 33.

Claim 33 depends from Claim 1 and recites a housing at least partially about the container, wherein the actuator includes a trigger having a depressment surface and does not extend radially outward beyond the housing. The prior art of record fails to disclose such an applicator. In contrast, both surface 30 of Gattone and lever 18 of Gebauer radially project outwardly beyond adjacent portions of housings. Accordingly, added Claim 33 is believed to be patentably distinct over the prior art of record.

H. Claims 34 and 35.

Claim 34 depends from Claim 1 and recites that the actuator has a forward most portion and that nozzle extends forwardly beyond the forward most portion. Claim 35 depends from Claim 1 and recites that the housing has a frusto-conical portion terminating at a tip and the actuator has a forward most portion rearward of the tip.

The prior art of record fails to disclose either of the limitations of Claim 34 or Claim 35. For example, for Gebauer to operate, Gebauer requires that its actuator 18, 22 project and extend forwardly beyond nozzle 19. Accordingly, added Claims 34 and 35 are each believed to be patentably distinct over the prior art of record.

I. Claim 36.

Claim 36 depends from Claim 1 and further recites that applicator includes a housing completely enclosing the container. Such an arrangement enables the housing to be ergonomically configured for enabling the applicator to be manipulated in a manner similar to that of a pen between a thumb, middle finger and an index finger.

The prior art of record fails to disclose the nail polish applicator recited in Claim 1 and further having a housing completely enclosing the container. For example, cap portion 12 of Gebauer (characterized as the housing) does not completely enclose container 10. Thus, added Claim 36 is believed to be patentably distinct over the prior art of record.

J. Claim 37.

Added Claim 37 recites a nail polish applicator which includes a container extending along a longitudinal axis, a nail polish under pressure within the container, a nozzle coupled to the container and having an outlet and an actuator configured to selectively dispense the nail polish through the nozzle. The nozzle is configured to dispense the nail polish along a dispensing axis substantially parallel or co-extensive with the longitudinal axis of the container. The applicator further includes a housing at least partially about the container and extending along the longitudinal axis. The housing has a frusto-conical nose proximate the nozzle.

The prior art of record fails to disclose the nail polish applicator of added Claim 37. For example, Gebauer fails to disclose a housing which has a frusto-conical nose portion. Cap element 12 of Gebauer (characterized as the housing) clearly does not have a frusto-conical nose portion. Moreover, Gattone also does not have a housing of a frusto-conical nose portion. The Office Action previously rejected Claim 10 which also recited a frusto-conical nose portion based upon Gattone. However, the Office Action failed to indicate where Gattone allegedly has a housing with a frusto-conical nose portion. Thus, Claim 37 is believed to be patentably distinct over the prior art of record.

VII. Conclusion.

After amending the claims as set forth above, claims 1-37 are now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date Nov. 30, 2004

By Todd A. Rathe

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5710
Facsimile: (414) 297-4900

Todd A. Rathe
Attorney for Applicant
Registration No. 38,276